

Application No.: 10/634,989

REMARKS

The indication of allowable subject matter in claims 6-14 is acknowledged and appreciated. In view of the following remarks, it is respectfully submitted that all claims are in condition for allowance.

Claims 1-5, 15-19 and 21-22 (renumbered as 20-21, respectively, to correct typographical error) stand rejected under 35 U.S.C. § 103 as being unpatentable over Hsu et al. '895 ("Hsu") in view of Ito et al. '730 ("Ito"). Claim 1 is independent. This rejection is respectfully traversed for the following reasons.

As a preliminary matter, it is respectfully submitted that in imposing a rejection under 35 U.S.C. § 103, the Examiner is required to point to "page *and line*" wherein an applied reference is perceived to identically disclose *each* feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). In the instant case, it is respectfully submitted that the Examiner broadly references a general portion of Hsu without specifically identifying the particular portion of Hsu that allegedly discloses *each* limitation of the pending claims. For example, page 3 of the outstanding Office Action references the same wide range of Hsu (i.e., col.'s 1,2) as allegedly disclosing the limitations set forth in claim 1, without identifying the specific line numbers (e.g., lines 45-47) allegedly disclosing each limitation. In other words, the Examiner in effect asserts generally that column's 1-2 of Hsu disclose the claimed features of claim 1 without specifying a narrow range of line numbers for each limitation.

Application No.: 10/634,989

In any event, it is respectfully submitted that the proposed combination does not disclose or suggest each and every limitation recited in the claims. As just one example, claim 1 recites in pertinent part, "a space area detecting step of detecting a space area which has a portion overlapping a layout pattern of at least one power supply wiring in a different layer and in which no layout pattern exists in the same layer of the space area." The Examiner alleges that the broad, wide-ranging disclosure at col.'s 1-2 of Hsu allegedly discloses a corresponding space area detecting step. However, it is respectfully submitted that the relied on portions of Hsu appear to be completely silent as to the claimed space area detecting step.

Specifically, Hsu, at best, appears to disclose only the detection of different pattern densities generally (*see* col. 1, lines 26-29). Hsu does not disclose or suggest a space area detecting step in which no layout pattern exists, let alone a step of specifically detecting a space area *which has a portion overlapping a layout pattern of at least one power supply wiring in a different layer* and in which no layout pattern exists *in the same layer of the space area* (*see, e.g.,* page 20, lines 20-25 and page 23, lines 2-13 of Applicants' specification corresponding to, for example, Figure 10 of Applicants' drawings). According to one aspect of the present invention, the "overlapping" could be useful for connecting a gate conductor with a first electric potential and connecting a substrate with a second electric potential, for example.

The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for establishing obviousness under § 103:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

Application No.: 10/634,989

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claim 1 because the proposed combination fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 1 is patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

Application No.: 10/634,989

including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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